

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application of: ADAMS *et al.*

Application No.: 09/817,278

Group Art Unit: 3743

Filed: March 27, 2001

Examiner: Ferko, K.

For: MULTI-MODE LIGHTER

Attorney Docket No.: 618-979

PETITION AND RESUBMISSION OF REQUEST FOR ORAL HEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

FAX RECEIVED

JUL 22 2003

GROUP 3700

BOARD OF PATENT
APPEALS &
INTERFERENCES
JUL 22 2003

Sir:

Pursuant to the provisions of 37 C.F.R. §§ 1.182 and/or 1.183, this is a Petition for reconsideration of, and/or relief from, the Order Returning Undocketed Appeal to Examiner mailed July 16, 2003 denying appellants' request for an oral hearing. Appellants submit herewith:

(1) a copy of the date-stamped postcard evidencing the filing of a Reply Brief in Response to Examiner's Answer and a separate oral hearing request on May 27, 2003, attached hereto as **Exhibit A**; and

(2) a marked-up version of the Request for Oral Hearing Under 37 CFR 1.194 filed by appellants on May 27, 2003, attached hereto as **Exhibit B**.

Please enter the following remarks into the file wrapper for the above-identified application:

CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being filed with the United States Patent and Trademark Office by facsimile transmission on July 22, 2003 to facsimile telephone number 703-308-7952.

Seth A. Watkins
For: Brian M. Rothery
Seth A. Watkins
For: Brian M. Rothery

Reg. No. 47,669
Reg. No. 35,340

BACKGROUND

Appellant timely filed a Reply Brief in Response to Examiner's Answer ("Reply Brief") on May 27, 2003. Appellant also timely filed a Request for Oral Hearing Under 37 CFR 1.194 ("Oral Hearing Request") on May 27, 2003.

In an Order Returning Undocketed Appeal to Examiner ("Order") mailed July 16, 2003, the Order states, in part, that "[o]n May 27, 2003, appellants timely filed a Reply Brief and a Request for Oral Hearing (Paper No. 23) as one paper in response to the Examiner's Answer." The Order further states:

... [O]n page 5 of the combined Reply Brief and Request for Oral Hearing, appellants included a section requesting an oral hearing in connection with the appeal, and note that a fee in the amount of \$280 is authorized for payment of same.

Effective December 1, 1997, 37 C.F.R. § 1.194(b) was amended to provide that a request for an oral hearing must be filed in a separate paper.

Since appellants' request for oral hearing was incorporated within the Reply Brief itself due to its continuing page numbering as page no. 5 of paper no. 23, it is not filed in a separate paper as required by 37 CFR § 1.194(b). Therefore, appellants' request for an oral hearing cannot be granted ...

* * *

If appellants still desire an oral hearing, a petition under 37 CFR § 1.183 must be filed within two weeks of the mail date of this notice ...

(Footnotes omitted).

The present Petition is thus filed under 37 CFR §§ 1.182 and/or 1.183 within two weeks of the mailing date of the Order Returning Undocketed Appeal to Examiner mailed July 16, 2003 denying appellants' request for an oral hearing.

ARGUMENT

Pursuant to 37 CFR § 1.194(b), "[i]f appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in § 1.17(d) within two months from the date of the examiner's answer."

A. Separate Captions and Signature Blocks.

On May 27, 2003, appellant filed two papers with the Board of Patent Appeals and Interferences in connection with the present application. First, appellant filed a Reply Brief. The four-page Reply Brief included a caption on the first page thereof identifying the application number, art unit number, name of the examiner, and title of the invention, as well

as the name of the applicant, filing date, and attorney docket number. On page four of the Reply Brief, a signature block was included indicating the date of the filing and the attorneys representing the present appellant. The signature block was executed in accordance with USPTO practice.

As a second, *separate* paper, appellant filed an Oral Hearing Request. The one-page Oral Hearing Request included a caption on page one thereof identifying the application number, art unit number, name of the examiner, and title of the invention, as well as the name of the applicant, filing date, and attorney docket number. The Oral Hearing Request also included a signature block indicating the date of the filing and the attorneys representing the present appellant. The signature block was executed in accordance with Patent Office practice. Finally, the Oral Hearing Request authorized Deposit Account payment of the oral hearing request fee under 37 CFR 1.17(d).¹

Pursuant to M.P.E.P. § 502, the Patent Office requests that each incoming paper pertaining to a filed application identify the application number, art unit number, name of the examiner, and title of the invention. The Reply Brief and Oral Hearing Request filed by appellants on May 27, 2003 *each* include separate captions provided in accordance with M.P.E.P. § 502. Clearly, if appellants instead had prepared the Reply Brief and the Oral Hearing Request as a combined document, as stated in the Order, there would have been no need for the separate captions.

Also, pursuant to 37 CFR § 1.33 and M.P.E.P. § 714.01(a), each paper filed with the Patent Office must be signed. The Reply Brief and Oral Hearing Request filed by appellants on May 27, 2003 *each* include separate executed signature blocks provided in accordance with CFR § 1.33 and M.P.E.P. § 714.01(a). Clearly, if appellants instead had prepared the Reply Brief and the Oral Hearing Request as a combined document, as stated in the Order, there would have been no need for the separate signature blocks.

Therefore, each of (1) the Reply Brief and (2) the Oral Hearing Request included a *separate* caption and signature block, as understood to be accepted practice when submitting *separate* papers to the Patent Office, thus indicating that these papers were not filed as a combined document.

¹ It is appellants' understanding that the \$280 fee for the oral hearing already has been charged, as authorized, to Pennie & Edmonds LLP Deposit Account No. 16-1150.

B. The Date-Stamped Postcard.

As additional evidence of appellants' intention that the Reply Brief and the Oral Hearing Request be considered by the Patent Office as separate papers, a copy of the date-stamped postcard evidencing the filing thereof is attached hereto as Exhibit A. Appellants *separately* noted on the dated-stamped postcard the filing of a "Reply Brief in Response to Examiner's Answer" and an "Oral Hearing Request" on May 27, 2003.

Because the Oral Hearing Request was intended and believed by appellants to be filed as a separate paper distinct from the Reply Brief, the date-stamped postcard *separately* itemized these papers.

C. Inadvertent Inclusion of a Page Number.

In an abundance of caution, appellants filed the Reply Brief and the Oral Hearing Request stapled together, as is typically appellants' practice when submitting several papers to the Patent Office on the same day in connection with a particular application. At the time of filing, appellants submitted the Oral Hearing Request *on top of* the Reply Brief. But despite being filed as a separate one-page paper placed on top of the Reply Brief, the Oral Hearing Request *inadvertently* included a page number "-5-" at the bottom of the page.

Thus, upon filing, the page numbers on the Oral Hearing Request ("-5-") and the Reply Brief (unnumbered page 1 through "-5-") were *out of sequence* when received by the Patent Office. The lack of sequential numbering of the pages filed with the Patent Office further indicates that appellants intended the Reply Brief and the Oral Hearing Request to be understood as filed as *separate papers*.

Because the Oral Hearing Request was intended and believed by appellants to be filed as a separate paper distinct from the Reply Brief, the page number on the bottom of the Oral Hearing Request was *unintentional, superfluous, and an inadvertent typographical error*.

D. Reconsideration and/or Relief from Denial of Request for Oral Hearing Is Warranted.

It was appellants' understanding upon the filing of the Reply Brief and the Oral Hearing Request that these papers were indeed *separate papers* -- as evidenced by (1) the *separate* captions and signature blocks on each of these papers, (2) the separate notations on the dated-stamped postcard evidencing the filing of a "Reply Brief in Response to

Examiner's Answer" and an "Oral Hearing Request", and (3) the filing of these papers with out of sequence page numbers.

To the extent that the Patent Office has interpreted appellants' filing of the Reply Brief and the Oral Hearing Request as a combined document, this petition thus respectfully requests suspension and/or waiver of the separate paper requirement of 37 CFR § 1.194(b) under 37 CFR § 1.183 in connection with the above-identified application because of the extraordinary situation as presented above. Appellants respectfully submit that the circumstances surrounding the filing of the Reply Brief and the Oral Hearing Request demonstrate good and sufficient cause for suspension and/or waiver of the separate paper requirement. The interests of justice favor the grant of appellant's Oral Hearing Request. To this end, attached hereto as Exhibit B, appellants provide a marked-up version of the Oral Hearing Request filed on May 27, 2003, with the inadvertent page number "-5-" crossed out. Appellants hereby Petition the Patent Office to consider the timely filed Oral Hearing Request as having been filed in compliance with applicable rules, and request that the Oral Hearing Request be granted.

In the event that this petition under 37 C.F.R. § 1.183 is denied, the Office is petitioned, in the alternative, to suspend and/or waive the separate paper requirement of 37 CFR § 1.194(b) under 37 CFR § 1.182 because the above-described situation is not specifically provided for in the regulations governing the rules of practice in patent cases.

Finally, in the event that this Petition under 37 C.F.R. §§ 1.182 and/or 1.183 is denied, it is respectfully requested that these papers be placed in the file wrapper in order to make these remarks of record for review by the Board. Members of the Board, upon review of the file, should be aware of the circumstances surrounding any denial of appellants' Oral Hearing Request.

A fee as set forth in 37 C.F.R. § 1.17(h) is believed to be due for this Petition and a Fee Transmittal Sheet is submitted concurrently herewith. Should any additional fees be required, please charge such fees to Pennie & Edmonds LLP Deposit Account No. 16-1150.

Respectfully submitted,

Seth A. Watkins

For: Brian M. Rothery

Date: July 22, 2003

Seth A. Watkins

Reg. No. 47,169

For: Brian M. Rothery

Reg. No. 35,340

PENNIE & EDMONDS LLP

1667 K Street, N.W.

Washington, DC 20006

(202) 496-4400

EXHIBIT A

Hand Carried - 5/27/03

Serial No. 09/817,278

Inventor ADAMS et al.

For MULTI-MODE LIGHTER

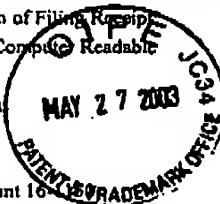
Filed March 27, 2001

- | | |
|---|---|
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| <input type="checkbox"/> Amendment <input type="checkbox"/> Response | <input type="checkbox"/> Fee Calculation |
| <input type="checkbox"/> Application pages | <input type="checkbox"/> Issue Fee Transmittal |
| <input type="checkbox"/> Claims Drawing Sheets | <input type="checkbox"/> Notice of Appeal |
| <input type="checkbox"/> Assignment <input type="checkbox"/> Cover Sheet | <input checked="" type="checkbox"/> Oral Hearing Request |
| <input checked="" type="checkbox"/> Reply Brief in Response to Examiner's Answer | <input type="checkbox"/> Petition to Extend Time months |
| <input type="checkbox"/> Declaration & Power of Attorney | <input type="checkbox"/> Petition Under 37 C.F.R. |
| <input type="checkbox"/> Executed <input type="checkbox"/> Unexecuted <input type="checkbox"/> Copy | <input type="checkbox"/> Power of Attorney |
| <input type="checkbox"/> Declaration of Inventors | <input type="checkbox"/> By Assignee <input type="checkbox"/> Associate <input type="checkbox"/> w/Revocation |
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| <input type="checkbox"/> Design Application | <input type="checkbox"/> Sequence Listing w/ Computer Readable and Paper Copy |
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| <input type="checkbox"/> w/refs. <input type="checkbox"/> w/o refs. | <input type="checkbox"/> Transmittal Letter |
| <input type="checkbox"/> Drawings, Formal | <input checked="" type="checkbox"/> Fee By Deposit Account 16 |
| Sheets Figures | |

Other:

File no.: 618-979-999

Sender: BMR/AMA/zmb



MARKED-UP VERSION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Application of: ADAMS *et al.*

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Group Art Unit: 3743

Filed: March 27, 2001

Examiner: Ferko, K.

For: MULTI-MODE LIGHTER

Attorney Docket No.: 618-979

EXHIBIT B

REQUEST FOR ORAL HEARING UNDER 37 § CFR 1.194

MS Appeal Brief - Patents
Assistant Commissioner for Patents
Washington, D.C. 20231

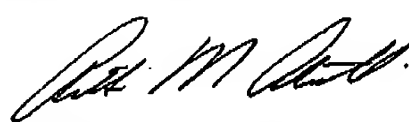
Sir:

In connection with the Appeal in the above-identified application, and further to the Examiner's Answer mailed March 25, 2003, Applicants hereby request an Oral Hearing.

The fee for this request is set by 37 CFR 1.17(d) and is believed to be \$280.00. Should any other fees be required, please charge all required fees under 37 C.F.R. 1.17 to Pennie & Edmonds Deposit Account No. 16-1150.

Respectfully submitted,

Date May 27, 2003


For: BRIAN M. ROTHERY
Arthur M. Antonelli Reg. No. 51,410
For: Brian M. Rothery Reg. No. 35,340

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Enclosures

DCI: 349610.1